

ENTERED

September 13, 2016

David J. Bradley, Clerk

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION**

**THE BOARD OF REGENTS OF THE
UNIVERSITY OF HOUSTON SYSTEM
ON BEHALF OF THE UNIVERSITY OF
HOUSTON SYSTEM AND ITS MEMBER
INSTITUTIONS et al.,**

Plaintiffs/Counter-Defendants,

v.

**HOUSTON COLLEGE OF LAW, INC.,
formerly known as SOUTH TEXAS
COLLEGE OF LAW,**

Defendant/Counter-Plaintiff.

CIVIL ACTION NO. 4:16-CV-1839

Honorable Keith P. Ellison

ORDER FOR SUPPLEMENTAL BRIEFING

Before the Court is Plaintiffs' Motion for Preliminary Injunction. In arguing the motion, the parties have primarily focused on the likelihood of point-of-sale confusion.¹ But, while point-of-sale confusion is the "most common and widely recognized type of confusion that creates infringement," it does not "mark the outer boundaries of trademark infringement." McCarthy, § 23:5. Indeed, as Plaintiffs correctly noted, (Doc. No. 45 ("Reply"), at 15), the Fifth Circuit has expressly adopted this broader conception of trademark infringement:

[Trademark infringement] can be based upon confusion that creates initial consumer interest, even though no actual sale is finally completed as a result of the confusion. Initial-interest confusion gives the junior user credibility during the early stages of a transaction and can possibly bar the senior user from consideration by the consumer once the confusion is dissipated.

Elvis Presley Enterprises, Inc. v. Capece, 141 F.3d 188, 204 (5th Cir. 1998).

¹ Point-of-sale confusion exists when a purchaser is confused as to a product's source at the time he purchases the product. 4 McCarthy on Trademarks and Unfair Competition § 23:5 (4th ed.).

Plaintiffs briefly referenced initial-interest confusion in their briefing, and both parties addressed it to varying degrees at the hearing,² but the Court requires further assistance in delineating the outer contours of the doctrine. The parties are therefore ordered to submit supplemental briefs addressing the doctrine of initial-interest confusion and its application to the case at bar.

Plaintiffs should file their supplemental briefing by no later than 11:59 p.m. on Tuesday, September 20, 2016. Defendant should file a brief in response by no later than 11:59 p.m. on Tuesday, September 27, 2016.

IT IS SO ORDERED.

SIGNED on this the 13th day of September, 2016.

A handwritten signature in black ink, appearing to read "Keith P. Ellison", written over a horizontal line.

KEITH P. ELLISON
UNITED STATES DISTRICT JUDGE

² (See Reply at 15 (citing *Elvis*, 141 F.3d at 204); PI Hr'g Tr. 88:14-89:6, 94:19-95:8, and 96:17-23 (Plaintiffs referencing initial interest confusion); and PI Hr'g Tr. 169-171 (Defendant discussing initial interest confusion).)